

REMARKS/ARGUMENTS

With entry of this amendment, Claims 9-25 and 34-48 are currently pending in this application. Claims 9 and 34 have been amended. Claims 1-8 and 26-33 have been canceled without prejudice to Applicants' right to prosecute the subject matter of the claims in a related, co-pending application. Claim 9 is amended to incorporate the limitations of Claims 7 and 8. Claim 34 is amended to include the limitations of Claim 33. No new matter is added by these amendments.

Rejections under 35 U.S.C. § 102(b)

Claims 1-4, 7, 26-30 and 33 stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by Stock *et al.*, U.S. Patent No. 6,011,858.

To expedite more compact prosecution of this case, Applicants cancel Claims 1-4, 7, 26-30 and 33 without prejudice to Applicants' right to prosecute the subject matter of these claims in a related, copending application.

Rejections under 35 U.S.C. § 102(e)

Claims 1-2, 7-8, 26 and 33 stand rejected under 35 U.S.C. § 102(e) as allegedly anticipated by Stratford *et al.*, U.S. Publication No. 2002/0021001 A1.

To expedite more compact prosecution of this case, Applicants cancel Claims 1-2, 7-8, 26 and 33 without prejudice to Applicants' right to prosecute the subject matter of these claims in a related, copending application.

Rejections under 35 U.S.C. § 103(a)

Claims 4-6, 8-25, 30-32 and 34-48 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Stock *et al.*, U.S. Patent no. 6,011,858, in view of Stratford *et al.* U.S. Publication 2002/021001 A1.

To expedite more compact prosecution of this case, Applicants cancel Claims 4-6 and 8 without prejudice to Applicants' right to prosecute the subject matter of these claims in a related, copending application.

With respect to Claims 9-25, Applicants respectfully traverse this rejection under 35 U.S.C. § 103. To establish a *prima facie* case of obviousness, the cited references must teach or suggest all of the claim limitations. There must be some suggestion or motivation, either in the reference(s) or in the knowledge generally available to one of ordinary skill in the art, to modify the reference(s) or to combine reference teachings. There must also be a reasonable expectation of success. (See MPEP § 2142.) Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be clear and particular. *Winner Int'l Royalty Corp. v. Wang*, 53 USPQ2d 1580, 1586-87 (Fed. Cir. 2000). "The mere fact that [a reference] may be modified in the manner suggested by the Examiner does not make the modification obvious unless the [reference] suggested the desirability of the modification." *In re Fritch*, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992).

The Stratford *et al.* publication is asserted to be a reference under 35 U.S.C. § 102(e)/103. To be a proper reference under 35 U.S.C. § 102(e), the invention must be "by another." See, e.g., *Riverwood International Corp. v. R.A. Jones & Co.*, 66 USPQ2d 1331, 1338 (Fed. Cir. 2003). See also MPEP § 2136.04. Applicants respectfully believe certain subject matter relied on by the Examiner in the Stratford *et al.* publication is not "by another," and thus the Stratford *et al.* publication is not a proper 35 U.S.C. § 102(e) reference.

The Stratford *et al.* publication was filed on April 6, 2001, and claims priority to U.S. Provisional Patent Application No. 60/195,618, filed April 7, 2000 (the Stratford Provisional Application). The Stratford *et al.* publication includes substantial new matter that is not disclosed in the Stratford Provisional Application. Therefore, the Stratford *et al.* publication is not entitled to the priority date of the Stratford Provisional Application for certain subject matter disclosed therein. Applicants more fully set forth below subject matter relied on by the Examiner that Applicants believe is not entitled to the priority date of the Stratford Provisional Application.

Further, Applicants respectfully believe certain subject matter disclosed in the Stratford *et al.* publication, and relied on by the Examiner, is actually Applicants' own invention. The Examiner is respectfully referred to the enclosed PCT publication WO 02/071225, filed April 6, 2001, in the name of the same inventive entity as this U.S. patent application: Shawn J. Bradley and Richard F. Peralta (the Bradley-Peralta PCT publication). The Bradley-Peralta PCT publication is entitled to a priority date of March 1, 2001, via U.S. Patent Application No. 09/797,751, for the subject matter disclosed therein. The subject matter of the Bradley-Peralta PCT publication and the priority document are the same.

The applicants for the Stratford *et al.* publication had access to the Bradley-Peralta U.S. Patent Application after its filing date, but prior to the U.S. filing date of the Stratford *et al.* publication. The Examiner will appreciate that substantial portions of the Bradley-Peralta PCT publication appear to have been copied into, or nearly paraphrased into, the Stratford *et al.* publication. Applicants believe many of these copied portions are Applicants' own work.

To facilitate further examination of this application, if requested by the Examiner, Applicants will submit a declaration attesting to these facts and Applicants' investigation into the proper inventive entity for the subject matter at issue in the Office Action. Applicants will also submit a copy of the Stratford Provisional Application upon request by the Examiner.

Referring to Claim 9, which depends on Claim 8, the Office Action acknowledges that Stock *et al.* does not disclose the claimed limitations of "wherein said processor is further configured to generate a binary number from the stored image of the biometric and in accordance with a preselected algorithm" as recited in Claim 8. Instead, the Office Action asserts the Stratford *et al.* publication discloses the aspect of generating a binary number from the stored image of the biometric by digitizing the biometric information (referring to the Stratford *et al.* publication, Page 3, Section 0029). This aspect is not disclosed in the Stratford *et al.* Provisional Application. Further, Applicants believe this disclosure is from Applicants own U.S. Patent Application No. 09/797,751, filed March 1, 2001, and thus is not "by another." The Examiner is referred to page 5, lines 9-16 for the same disclosure.

Referring to Claim 10, the Office Action alleges the Stratford *et al.* publication discloses the aspect of generating a binary number from the biometric image by digitizing the biometric information (referring to the Stratford *et al.* publication, Page 3, Section 0029). This aspect is not disclosed in the Stratford *et al.* Provisional Application. Further, Applicants believe this disclosure was derived from Applicants' own U.S. Patent Application No. 09/797,751, filed March 1, 2001. The Examiner is respectfully referred to the Bradley-Peralta PCT publication, page 5, lines 9-16 for the same disclosure.

Referring to Claim 12, the Office Action alleges the Stratford *et al.* publication disclose the aspect of generating a binary number from the biometric image by digitizing the biometric information (referring to Stratford *et al.* Page 3, Section 0029). As discussed above, this aspect is not disclosed in the Stratford *et al.* Provisional Application. Further, Applicants believe this disclosure was derived from Applicants' own U.S. Patent Application No. 09/797,751, filed March 1, 2001. The Examiner is respectfully referred to the Bradley-Peralta PCT publication, page 5, lines 9-16 for the same disclosure.

Therefore, Applicants believe a proper *prima facie* case has not been established under 35 U.S.C. §§ 102(e)/103 because the disclosure in the Stratford *et al.* publication relied on by the Office is Applicants' own invention.

Referring to Claims 11 and 13-25, Applicants believe that because the claims from which these claims depend, Claims 9 and 10, are not obvious, Claims 11 and 13-25 are also not obvious.

Referring to Claims 30-32, to expedite more compact prosecution of this case, Applicants cancel Claims 30-32 without prejudice to Applicants' right to prosecute the subject matter of these claims in a related, copending application.

Referring to Claim 34, the Office Action acknowledges Stock *et al.* does not disclose the claimed limitations of "wherein said processor is further configured to generate a binary number from the stored image of the biometric and in accordance with a preselected algorithm." The Office Action alleges the Stratford *et al.* publication discloses the aspect of

generating a binary number from the stored image of the biometric by digitizing the biometric information (referring to Stratford *et al.*, Page 3, Section 0029). As discussed above, this aspect is not disclosed in the Stratford *et al.* Provisional Application. Further, Applicants believe this disclosure was derived from Applicants own U.S. Patent Application No. 09/797,751, filed March 1, 2001. The Examiner is respectfully referred to the Bradley-Peralta PCT publication, page 5, lines 9-16 for the same disclosure.

Therefore, Applicants believe a proper *prima facie* case has not been established under 35 U.S.C. § 102(e)/103 because the disclosure in the Stratford *et al.* publication relied on by the Office is Applicants' own invention.

Referring to Claims 35-48, Applicants believe these claims are not obvious because Claim 34, from which these claims depend, is not obvious.

Applicants therefore respectfully request the Examiner reconsider and withdraw the rejections of Claims 9-25 and 35-48 as allegedly obvious.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

Appl. No. 09/945,261
Amdt. dated June 3, 2004
Reply to Office Action of December 3, 2003

PATENT

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 206-467-9600.

Respectfully submitted,

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